



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,122	07/10/2001	Masataka Takeuchi	Q61612	7232

7590 10/24/2003

SUGHRUE, MION, ZINN,
MACKPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER	
WEINER, LAURA S	
ART UNIT	PAPER NUMBER
1745	

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,122

Applicant(s)

TAKEUCHI ET AL.

Examiner

Laura S Weiner

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1745

DETAILED ACTION

Election/Restrictions

1. Claims 19-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 as follows:

The provisional application 60/245,717 is written in Japanese and not in English, therefore the application could not be understood and used to verify filing date. No Japanese translation has been received.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Response to Amendment

3. The Declaration under 37 CFR 1.132 filed 9-24-03 is insufficient to overcome the rejection of claims 1, 2, 6-18 based upon 35 U.S.C. 102 (b) as set forth in the last Office action because: The reference that was used was JP 2000-67643 filed on August 19, 1998 and not JP 2000-67673 filed on August 19, 1988.

Response to Arguments

4. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

5. Claims 3-5, 7-12, 14, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is rejected because the claim is dependent on claim 1 which is drawn to a solid polymer electrolyte comprising a polymer compound and at least one electrolyte salt. The claim cannot depend on claim 1 if the dependency is because of just the polymer compound and not the solid polymer electrolyte. If the polymer is what is wanted then the claim should depend from a claim which is drawn to a polymer described as formula (1) or formula (II). Applicant argued that claim 3 does not contain an electrolyte salt therefore, the claim should not be drawn to a solid polymer electrolyte but instead to "a polymer of a polymerizable compound". In which case a new

Art Unit: 1745

restriction will be issued. A solid polymer electrolyte would inherently have to have an electrolyte salt in addition to a polymer.

Claim 7 is rejected because the claim is dependent on claim 3 and claim 1 in which is drawn to a solid polymer electrolyte and not to a polymerizable compound. If the polymer is what is wanted then the claim should depend from a claim which is drawn to a polymerizable compound and not drawn to a solid polymer electrolyte. After further consideration and after reading Applicants arguments, this claim and its dependent claims should be restricted out from Group I because the claim is not drawn to a solid polymer electrolyte but instead to a precursor.

Claim Rejections - 35 USC § 102

6. Claims 1-2, 6-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al. (JP 2000-67643, abstract).

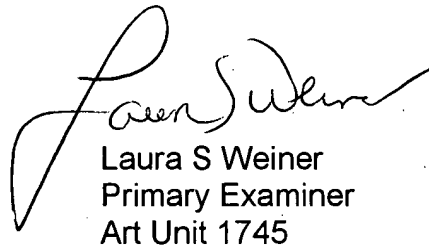
Takeuchi et al. teaches an electrolyte for batteries which includes a polymer of at least one kind of polymerizable compound having a carbonate group represented by formula (I), R1 is 1-10C divalent group optionally including a chained, branched or cyclic hetero atom, m is an integer of 1-10 and n is an integer of 1-1000. When a plurality of R1 exist, they are optionally same or different with each another and a polymerizable functional group represented by formula II and at least one kind of electrolytic salt. Takeuchi et al. teaches in column 14, lines 9-30, that the electrolyte salt comprises LiCF₃SO₃, LiN, LiPF₆, NaPF₆, etc. and in column 28, lines 1-38, that EC and DEC are included and LiPF₆/EC+DEC.

Art Unit: 1745

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura S Weiner whose telephone number is 703-308-4396. The examiner can normally be reached on M-F (7:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 703-308-2383. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Laura S Weiner
Primary Examiner
Art Unit 1745

October 23, 2003